

11-23-01  
-1-

Docket No. 18950-71

A

Practitioner's Docket No. 18950-71

**PATENT**

Preliminary Classification:

Proposed Class:

Subclass:

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Box Patent Application  
Commissioner for Patents  
Washington, D.C. 20231

**NEW DIVISIONAL APPLICATION TRANSMITTAL**

Transmitted herewith for filing is the patent application of

Inventors: **John Francis Gordon**

For (title): **APPARATUS AND METHOD FOR CARRYING OUT ANALYSIS OF SAMPLES USING  
SPLIT BEAM RADIATION INSPECTION**

**CERTIFICATION UNDER 37 C.F.R. § 1.10**

I hereby certify that this New Application Transmittal and the documents referred to as attached therein are being deposited with the United States Postal Service on this date November 16, 2001, in an envelope as "Express Mail Post Office to Addressee," mailing Label Number EL585705523US, addressed to the: Commissioner for Patents, Washington, D.C. 20231.

Jessica Brown

(type or print name of person mailing paper)

Jessica Brown  
Signature of person mailing paper

1. **Type of Application**

This new application is for a(n)

*(check one applicable item below)*

- ☒ Original (nonprovisional)  
☐ Design  
☐ Plant

2. **Benefit of Prior U.S. Application(s)** (35 U.S.C. §§ 119(e), 120, or 121)

- ☒ The new application being transmitted claims the benefit of prior U.S. application(s). Enclosed are ADDED PAGES FOR NEW APPLICATION TRANSMITTAL WHERE BENEFIT OF PRIOR U.S. APPLICATION(S) CLAIMED.

3. **Papers Enclosed**

A. Required for filing date under 37 C.F.R. § 1.53(b) (Regular) or 37 C.F.R. § 1.153 (Design) Application

24 Pages of specification  
9 Pages of claims (5 pages of original claims; 4 pages of claims as amended)  
6 Sheets of drawings as originally filed in the parent and CIP serial no. 09/643,030  
\_\_\_\_\_ Sheets of formal drawings

*(complete the following, if applicable)*

- ☐ The enclosed drawings are formal drawings.  
☐ formal  
☒ informal

B. Other Papers Enclosed

5 Pages of declaration and power of attorney  
\_\_\_\_\_ Pages of abstract  
2 Other ① **Revocation/Appointment of Power of Attorney or Authorization of Agent**  
② **Certificate Under 37 CFR 3.73(b)**

4. **Additional papers enclosed**

- ☒ Amendment to claims  
☒ Cancel in this application claims 2-13  
before calculating the filing fee. (At least one original independent claim must be retained for filing purposes.)  
☐ Add the claims shown on the attached amendment. (Claims added have been numbered consecutively following the highest numbered original claims.)  
☒ Preliminary Amendment  
☒ Information Disclosure Statement (37 C.F.R. § 1.98)  
☒ Form PTO-1449 (PTO/SB/08A and 08B)

- ☐ Citations
- ☐ Authorization of Attorney(s) to Accept and Follow Instructions From Representative
- ☐ Special Comments
- ☐ Other

**5. Declaration or oath (including power of attorney)**

☒ Enclosed

Executed by

*(check all applicable boxes)*

- ☒ inventor(s)
- ☐ legal representative of inventor(s).  
37 C.F.R. §§ 1.42 or 1.43.
- ☐ joint inventor or person showing a proprietary interest on behalf of inventor who refused to sign or cannot be reached.
  - ☐ This is the petition required by 37 C.F.R. § 1.47 and the statement required by C.F.R. § 1.47 is also attached. See item 13 below for fee

☐ Not Enclosed.

☐ Application is made by a person authorized under 37 C.F.R. § 1.41(c) on behalf of *all* the above named inventor(s).

*(The declaration or oath, along with the surcharge required by 37 C.F.R. § 1.16(e) can be filed subsequently).*

☐ Showing that the filing is authorized.  
*(not required unless called into question. 37 C.F.R. § 1.41(d))*

**6. Inventorship Statement**

The inventorship for all the claims in this application are:

☒ The same.

**or**

- ☐ Not the same. An explanation, including the ownership of the various claims at the time the last claimed invention was made,
  - ☐ is submitted.
  - ☐ will be submitted.

**7. Language**

☒ English

☐ Non-English

☐ The attached translation includes a statement that the translation is accurate.  
37 C.F.R. § 1.52(d).



**9. Certified Copy**

Certified copy(ies) of application(s)

|         |           |       |
|---------|-----------|-------|
| Country | Appln No. | Filed |
| Country | Appln No. | Filed |
| Country | Appln No. | Filed |

from which priority is claimed

- ☐ is (are) attached).
- ☐ will follow.

**10. Fee Calculation (37 C.F.R. § 1.16)**

A. ☒ Regular application

| CLAIMS AS FILED  |    |        |              |            |  |
|--|----|--------|--------------|------------|--|
| Number Filed   |    |        | Number Extra | Rate       | Basic Fee<br>37 C.F.R. § 1.16(a)<br>\$710.00 |
| Total<br>Claims (37 C.F.R.<br>§ 1.16(c))                     | 20 | - 20 = | 0            | x \$ 18.00 | 0.00   |
| Independent<br>Claims (37 C.F.R.<br>§ 1.16(b))               | 2  | - 3 =  | 0            | x \$ 80.00 | 0.00   |
| Multiple dependent claim(s),<br>if any (37 C.F.R. § 1.16(d)) |    |        |              | + \$260.00 | 0.00   |

- ☐ Amendment canceling extra claims is enclosed.
- ☐ Amendment deleting multiple-dependencies is enclosed.
- ☐ Fee for extra claims is not being paid at this time.

Filing Fee Calculation \$ 710.00

B. ☐ Design application  
(\$310.00—37C.F.R. § 1.16(f))

Filing Fee Calculation \$ \_\_\_\_\_

C. ☐ Plant application  
(\$480.00—37 C.F.R. § 1.16(g))

Filing Fee Calculation \$ \_\_\_\_\_

OFFICE OF THE COMPTROLLER OF THE PATENT AND TRADEMARK OFFICE

11. **Small Entity Statement(s)**

- ☒ Statement(s) that this is a filing by a small entity under 37 C.F.R. § 1.9 and 1.27 is (are) attached.

*(complete the following, if applicable)*

- ☒ Status as a small entity was claimed in the prior application  
09 / 156,475, filed on September 18, 1998, from which benefit  
is being claimed for this application under:

35 U.S.C. § ☐ 119(e),

☒ 120,

☐ 121,

☐ 365(c),

and which status as a small entity is still proper and desired.

- ☒ A copy of the statement in the prior application is included.

Filing Fee Calculation (50% of **A**, **B** or **C** above)

\$ 355.00

12. **Request for International-Type Search (37 C.F.R. § 1.104(d))**

*(complete, if applicable)*

- ☐ Please prepare an international-type search report for this application at the time  
when national examination on the merits takes place.

For Filing Fee

13. Fee Payment Being Made at This Time

☐ Not Enclosed

☐ No filing fee is to be paid at this time.  
(This and the surcharge required by 37 C.F.R. § 1.16(e) can be paid subsequently.)

☒ Enclosed

|   |                  |
|---|------------------|
| <input checked="" type="checkbox"/> Filing Fee  | \$ <u>355.00</u> |
| <input type="checkbox"/> Recording Assignment<br>(\$40.00; 37 C.F.R. § 1.21(h))<br>(See attached "COVER SHEET FOR<br>ASSIGNMENT ACCOMPANYING NEW<br>APPLICATION".)  | \$ _____         |
| <input type="checkbox"/> Petition fee for filing by other than all the<br>inventors or person on behalf of the inventor<br>where inventor refused to sign or cannot be<br>reached<br>(\$130.00; C.F.R. §§ 1.47 and 1.17(i)) | \$ _____         |
| <input type="checkbox"/> For processing an application with a<br>specification in<br>a non-English language<br>(\$130.00; 37 C.F.R. §§ 1.52(s) and 1.17(k))   | \$ _____         |
| <input type="checkbox"/> Processing and retention fee<br>(\$130.00; 37 C.F.R. §§ 1.53(d) and 1.21(i))   | \$ _____         |
| <input type="checkbox"/> Fee for international-type search report<br>(\$40.00; 37 C.F.R. § 1.21(e))   | \$ _____         |
| Total fees enclosed   | \$ <u>355.00</u> |

14. Method of Payment of Fees

☒ Check in the amount of \$ 355.00

☒ Charge Account No. \_\_\_\_\_ in the amount of  
\$ \_\_\_\_\_  
A duplicate of this transmittal is attached.

**15. Authorization to Charge Additional Fees**

☒ The Commissioner is hereby authorized to charge the following additional fees by this paper and during the pendency of this application to Account No.

16-2230

☒ 37 C.F.R. § 1.16(a), (f) or (g) (filing fees)

☒ 37 C.F.R. § 1.16(b), (c) and (d) (presentation of extra claims)

☐ 37 C.F.R. § 1.16(e) (surcharge for filing the basic filing fee and/or declaration on a date later than the filing date of the application)

☒ 37 C.F.R. § 1.17(a)(1)-(5) (extension fees pursuant to § 1.136(a)).

☒ 37 C.F.R. § 1.17 (application processing fees)

☐ 37 C.F.R. § 1.18 (issue fee at or before mailing of Notice of Allowance, pursuant to 37 C.F.R. § 1.311(b))

**16. Instructions as to Overpayment**

☒ Credit Account No. 16-2230

☐ Refund

Dated: November 16, 2001



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OPPENHEIMER WOLFF & DONNELLY LLP  
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Los Angeles, California 90067  
(310) 788-5000

18950-71-16-2230



☒ **Incorporation by reference of added pages**

*(check the following item if the application in this transmittal claims the benefit of prior U.S. application(s) (including an international application entering the U.S. stage as a continuation, divisional or C-I-P application) and complete and attach the ADDED PAGES FOR NEW APPLICATION TRANSMITTAL WHERE BENEFIT OF PRIOR U.S. APPLICATION(S) CLAIMED)*

- ☒ Plus Added Pages for New Application Transmittal Where Benefit of Prior U.S. Application(s) Claimed

Number of pages added 1

- ☒ Plus Added Pages for Papers Referred to in item 4 Above

Number of pages added \_\_\_\_\_

- ☐ Plus added pages deleting names of inventor(s) named in prior application(s) who is/are no longer inventor(s) of the subject matter claimed in this application

Number of pages added \_\_\_\_\_

- ☐ Plus "Assignment Cover Letter Accompanying New Application"

Number of pages added \_\_\_\_\_

☐ **Statement Where No Further Pages Added**

*(if no further pages form a part of this Transmittal, then end this Transmittal with this page and check the following item)*

- ☐ This transmittal ends with this page.

03961429 111501  
T09T1529

**ADDED PAGE(S) FOR SPECIAL COMMENTS FOR NEW APPLICATION  
TRANSMITTAL**

THIS APPLICATION IS A DIVISIONAL OF COPENING APPLICATION SERIAL NO. 09/643,030,  
FILED AUGUST 21, 2000, WHICH IS A CONTINUATION OF COPENING APPLICATION SERIAL  
NO. 09/156,475, NOW U.S. PATENT NO. 6,256,088, FILED SEPTEMBER 18, 1998; WHICH IS A  
CONTINUATION OF APPLICATION SERIAL NO. 08/809,402, NOW U.S. PATENT NO. 5,892,577,  
FILED JULY 28, 1997 ISSUED ON APRIL 6, 1999; WHICH IS A 371 CONTINUATION OF  
PCT/GB95/02186, FILED SEPTEMBER 15, 1995, WHICH CLAIMS PRIORITY FROM UK PATENT  
APPLICATION NO. 9418981.8 FILED SEPTEMBER 21, 1994.

Added Page 1

Under the Paper Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

**STATEMENT UNDER 37 CFR 3.73(b)**

Applicant/Patent Owner: Gordon, John Francis

Application No.: 09/156,475 Filing Date: September 18, 1998

Entitled: APPARATUS AND METHOD FOR CARRYING OUT ANALYSIS OF SAMPLE

THE UNIVERSITY COURT OF THE UNIVERSITY OF GLASGOW, a university  
(Name of assignee) (Type of Assignee, e.g., corporation, partnership, university, government agency, etc.)

states that it is:

- ☒ the assignee of the entire right, title, and interest; or  
☐ an assignee of an undivided part interest

the patent application/patent identified above by virtue of either:

- ☒ An assignment from the inventor(s) of the patent application/patent identified above. The assignment was recorded in the Patent and Trademark Office at Reel 8634, Frame 0810, or for which a copy thereof is attached.

OR

- ☐ A chain of title from the inventor(s), of the patent application/patent identified above, to the current assignee as shown below:

1. From: \_\_\_\_\_ To: \_\_\_\_\_  
The document was recorded in the Patent and Trademark Office at  
Reel \_\_\_\_\_, Frame \_\_\_\_\_, or for which a copy thereof is attached.

2. From: \_\_\_\_\_ To: \_\_\_\_\_  
The document was recorded in the Patent and Trademark Office at  
Reel \_\_\_\_\_, Frame \_\_\_\_\_, or for which a copy thereof is attached.

3. From: \_\_\_\_\_ To: \_\_\_\_\_  
The document was recorded in the Patent and Trademark Office at  
Reel \_\_\_\_\_, Frame \_\_\_\_\_, or for which a copy thereof is attached.

☐ Additional documents in the chain of title are listed on a supplemental sheet.

☐ Copies of assignments or other documents in the chain of title are attached.

**[NOTE:** A separate copy (i.e., the original assignment document or a true copy of the original document) must be submitted to Assignment Division in accordance with 37 CFR Part 3, if the assignment is to be recorded in the records of the PTO. See MPEP 302-302.8]

The undersigned (whose title is supplied below) is empowered to sign this statement on behalf of the assignee.

11/15/02  
Date

Pilly Harkin  
Signature

Pilly Harkin  
Typed or printed name

Strategic Business Development Manager  
Title